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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,369	07/02/2001	Aziz Valliani	A-70469/MAK/LM	2759
30636	7590	09/29/2005	EXAMINER	
FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			KRAMER, JAMES A	
			ART UNIT	PAPER NUMBER
			3627	
DATE MAILED: 09/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/899,369

Applicant(s)

VALLIANI ET AL.

Examiner

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storey in view of Walker et al.

Storey teaches a fully integrated, on-line interactive frequency and award redemption program. Storey teaches that various manufacturers register with this system (identified as PRODUCT A, PRODUCT B, PRODUCT C, etc in the reference). When a user purchases an item from one of the manufacturers the system credits an account associated with the user with a certain amount of awards points based on a preprogrammed formula (column 5; lines 45-50).

Storey further teaches that the selection of available prizes (redeemable via awards points) is expanded by the merchants who join the program (column 2; lines 31-34). Examiner notes that it is inherent to this statement that upon joining the program companies condition the grant of a discount for a product from their company upon the purchase of a product from a different company.

Examiner notes that Storey fails to teach collecting cross-marketing revenue realized from the purchase of the original product and allocating a portion of that money to the company that provides the prize of cross-sell product.

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Walker et al. teaches a method and apparatus for providing supplementary product sales to a customer at a customer terminal. In particular the system includes a reconciliation of money between a company associated with the primary product and the upsell product. In particular the upsell merchant is credited with funds in order to compensate them for the benefit received from the primary company (column 10; lines 30-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Storey by allocating an reconciliation process as taught by Walker et al. in order for a secondary merchant to receive compensation for offering an award to a customer of the primary merchant.

***Claim Rejections - 35 USC § 103***

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. in view of Walker.

With respect to claim 15, Deaton teaches at a company, identifying the purchase of a first product of a first department by a particular consumer at an electronic sales terminal and storing an indication of the purchase of the first product in the database on the server (see for example column 69, lines 53-56). Examiner specifically notes the determination of whether a product has been purchased from the meat department, dairy department or deli.

Deaton further teaches presenting consumers with discounts on further purchases based on past purchasing history (see for example column 69, lines 59-61), as well as offering for sale a second product and standing ready to accept the discount at the same or different one of the

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plurality of sales terminals on the second product (Examiner notes that this merely amounts to accepting the coupon at the store).

Examiner points out that the specific examples of Deaton illustrate situations the discount is provided to the user based upon infrequent shopping in a department with the goal of enticing a shopper to visit and purchase products from a department they wouldn't regularly visit (see for example column 69, lines 61-67). As such Deaton fails to specifically teach conditioning the grant of a discount for the second product at a second department on a purchase of a first product at a first department.

Walker, as previously discussed teaches presenting users with offers for supplementary products ("upsells") in order to individually customize offers to be more desirable and acceptable to each customer (see for example column 3, lines 30-39).

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the discount offers taught by Deaton to include "upsell" products as taught by Walker. One of ordinary skill in the art would have been motivated to modify the references in order to individually customize offers to be more desirable and acceptable to each customer.

Examiner notes that one of ordinary skill would recognize that the combination of Deaton in view of Walker as presented above would clearly include conditioning the grant of a discount for the second product at a second department on a purchase of a first product at a first department. By way of simple example, Examiner offers providing a user with a discount ("upsell") on hot dog buns (bakery department) upon the purchase of hot dogs (meats department).

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Examiner finds that claim 16 is substantially similar to claim 15, save the following issues. Deaton further teaches crediting an account of the consumer maintained on the server with the discount (see for example column 73, lines 25-30). Examiner notes that providing the coupon to the consumer represents “notifying the consumer of the discount”. Further, in order to track which coupons a consumer has used the system must store an indication of the coupon (discount) in an account on a server.

Examiner notes that Deaton does not teach depositing money into an account on the server for the benefit of the second department in at least partial compensation for accepting the discount wherein the money deposited into the account for the benefit of the second department amounts to a predetermined percentage of revenue realized from the purchase of the first product.

Examiner once again relies on Walker, as discussed in detail above with respect to supplementary product offerings or “upsells”. Further, Walker teaches compensation paid as a result of issuing a discount on a second product based on the purchase of a first product (see column 10, lines 22-60). In this example a user pays 4.50 in return for \$5 off a future purchase. The \$4.5 (predetermined amount of money) is deposited into an account for the benefit of the second company.

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the teaching of Deaton to include the reconciliation process of Walker in order to compensate the second company for issuing the discount.

***Response to Arguments***

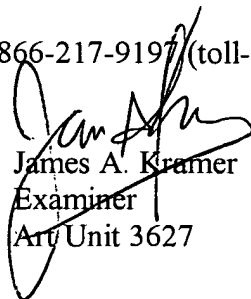
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Applicant's arguments, see Appeal Brief, filed 7/15/05, with respect to the rejection(s) of claim(s) 15 and 16 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free),

 9/22/05  
James A. Kramer  
Examiner  
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jak